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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/824,889	
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	First Named Inventor	Toby Wexler	
	Art Unit	1644	
	Examiner Name	Kimberly Smith	
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE,**

**DATE: 27 October 2006  
SERIAL NO. 10/824,889  
FILED: 04/14/2004**

**APPLICANT: Toby Wexler  
GROUP ART UNIT: 1644  
EXAMINER: Kimberly Smith**

**FOR: An animal toe nail covering and method of manufacture**

**Commissioner of Patents  
P.O. Box 1450 Alexandria VA 22313-1450**

**BRIEF of APPELLANT Under 37 CFR 41.37(c) (1)**

This is an amended appeal in response to the Notice of Non-compliant Appeal Brief dated 10/23/2006 stemming from the final rejection of the application dated 1/3/2006 in which all claims were rejected.

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**(c)(1)(i) REAL PARTY OF INTEREST-**

**The real party of interest is the inventor Toby Wexler**

**(c)(1)(ii) RELATED APPEALS AND INTERFERENCES-**

**None,**

### **(c)(1)(iii) STATUS OF CLAIMS**

**Claims 1-17 and claims 27-39 are appealed**

The status of the claims as set out in the advisory action dated 03/17/2006, received after submission of amended application, were as follows:

**Allowed claims—none**

**Claims objected to—none**

**Claims rejected— 1-7, 11, 14-17 and 27-39.**

**Claims canceled 8-10, 12-13 and 18-26**

**Claims 27-39 stand rejected for the first time before the case was closed on the merits.**

The application was filed as a 37 C.F.R. 1.16 utility application on 04/14/2004 with twenty-six (26) claims of which nine (9) were independent claims (Claims 1, 18-23, 25 and 26.

Restriction was required, Claims 1-17 were elected with traverse. Restriction was maintained resulting in claims 8-10, 12, 13, and 18-26 being withdrawn and subsequently canceled and new claims 27-39 being added.

The claims were then examined and all of the pending claims were rejected by the 1<sup>st</sup> office action dated 9/1/2005.

In applicants' response to the 1<sup>st</sup> office action dated 10/15/2005, claims 27-39 were added and claims 1-7, 11, and 14-17 were amended.

The 2<sup>nd</sup> Office Action dated 01/03/2006 was a final rejection of all of the claims (Claims 1-7, 11, 14-17, and 27-39) even though claims 27-39 were only rejected once. Applicant responded with an amendment after final dated 2/23/2006.

**(c)(1)(iv) STATUS OF AMENDMENTS**

Applicant's amendment of 2/23/2006 after final rejection was not entered.

### **(c)(1)(v) SUMMARY OF THE CLAIMED SUBJECT MATTER**

The improved sheath according to Independent claim 1 comprises an improved animal toe nail cap or cover 16, that distinguishes over applicant's prior patent 4,962,731 in that the improvement is directed to a polymeric animal toe nail cap or sheath 16 having an internal and external claw shape consistent with an animal's toe-nail for encompassing only the nail portion of the animal's toe as seen in Fig. 10. The improvement comprising a surrounding wall or layer 42 covering at least a portion of the sheath 16. The surrounding outer layer 42 is molecularly bonded to the sheath 16 in a double dip molding process making the composition a single piece as described on Page 11 line 3 –5.

The improved sheath according to dependent claim 2 relates to an animal toenail covering 16 having an external coating of polymer 42 as seen In Fig. 10 with a hardness or durometer greater than that of the polymeric sheath 16 as disclosed on page 11 line 7-19.

The improved sheath according to dependent claim 3 relates to a polymeric sheath having an external coating wherein the polymer sheath 16 and the coating 42 are different colors as disclosed on Page 11 line 7.

The improved sheath according to dependent claim 4 relates to a polymeric sheath having internal anticline cleats 44 as seen in Figs. 12-14 and disclosed on page 12 lines 4-7.

The improved sheath according to dependent claim 5 relates to an animal toenail polymeric sheath 16 having a partial delamination 24 between the polymeric sheath 16 and a portion of the external coating of polymer 42 as shown in Fig. 13 and disclosed on page 12 lines 15 and 16.

The improved sheath according to dependent claim 6 relates to an animal toenail covering wherein the polymeric sheath 16 has an adhesive element 48 as shown in Fig. 13 and disclosed on page 12 line 20-21.

The improved sheath according to dependent claim 7 relates to an animal toenail covering wherein the adhesive element is a liquid adhesive inserted between said polymeric sheath 16 and the external coating of polymer 42 as seen In Fig. 13 and disclosed on page 12 lines 19-20 .



The improved sheath according to dependent claim 11 relates to an animal toenail covering 40 comprising a sheath 16 having a textured inner wall surface as seen in Fig. 12 and disclosed on page 12 lines 8-10.

The improved sheath according to dependent claim 14 relates to an animal toenail covering 16 having an adhesive powder 82 element as seen in Fig. 26 and disclosed on page 15 lines 5-6.

The improved sheath according to dependent claim 15 relates to an animal toenail covering 16 having an aerosol induced adhesive element 60 as shown in Fig. 20 and disclosed on page 14 lines 1-3.

The improved sheath according to dependent claim 16 relates to an animal toenail covering having an adhesive powder applied to the polymeric sheath by the tooling used in the dip molding process for forming the polymeric sheath 16 as shown in Fig. 21 and disclosed on Page 14 lines 4-11.

The improved sheath according to dependent claim 17 relates to an animal toenail covering having an adhesive powder applied to the mold tooling by an electrostatic means as shown in Fig. 26 and disclosed on page 15 lines 4-12. The means being an electrical charge placed on the dip molding tool and exposing the mold to an adhesive powder thereby attracting a quantity of adhesive powder to the mold prior to dipping into a polymer.

The improved sheath according to Independent claim 27 relates to a polymeric animal toenail covering having an internal cavity and an external shape defining a pliable sheath 16 generally consistent with that of an animal toenail for incasing an animal toenail 12 as shown in Fig. 11. The sheath 16 having an external coating of polymer 42 encompassing at least a portion of the sheath 16.

The improved sheath according to Independent claim 28 relates to a polymeric animal toenail covering 40 having an external coating 42 having a greater hardness than the covering 40 as shown in Fig. 10 and as disclosed on page 11 lines 7-19.

The improved sheath according to Independent claim 29 relates to a polymeric animal toenail covering 40 comprising a sheath 16 having a coating 42 that is a different color than sheath 16 as shown in Fig. 10 and as disclosed on page 11 lines 7-19.

The improved sheath according to Independent claim 30 relates to a polymeric animal toenail covering 40 having a coating 42 applied to a sheath 16 in a manner whereby a void is formed between the coating 42 and a portion of the sheath 16 as shown in Fig. 13 and disclosed on page 12 lines 17-19.

The improved sheath according to Independent claim 31 relates to a polymeric animal toenail covering 40 comprising a sheath 16 having a plurality of pliable anticline cleats 44 located therein protruding inwardly as shown in Figs. 12-14 and disclosed on page 12 lines 4-8.

The improved sheath according to independent claim 32 relates to a polymeric animal toenail covering 40 seen in Fig. 11 having a closed distal end and a open proximate end the covering having an internal cavity 26 and a external shape defining a pliable sheath generally consistent with that of an animal toenail for telescopically encasing an animal toenail 12 in the manner shown in Fig. 5 the sheath 40 further comprising a non-uniform wall thickness having a greater thickness as a result of the second layer at the lower of distal end than at the proximate end as described on page 11 lines 7-10.

The improved sheath according to independent claim 38 relates to a polymeric animal toenail sheath 16 having an exterior surface and a rectangular opening 26 to an interior cavity both the exterior surface and the interior cavity defining a pliable sheath 40 having a general shape consistent with that of an animal toenail 12 as shown in Fig. 5 the sheath defining a telescopic relationship by slidably extending over an animal toenail 12, thus encasing and providing protection to others there from, said sheath comprising 40 further having a polymeric overlay conforming to the general shape of the exterior surface of the sheath 16 .

**(c)(1)(vi) Grounds For Rejection**

1. Claims 1,2, and 5, 27, 28, 30, and 32-35 stand rejected under 35 U.S.C. 102 (b) as being anticipated by *Field* U.S. Patent 4,908,881.
2. Claims 3, 6, 7, and 14-17 29, 36, and 38-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Field* U.S. Patent 4,908,881.
3. Claims 4,11,31, and 37 are further rejected under 35 U.S.C. 103(a)as being unpatentable over Field in view of Johns 2,285,981.

### **(c)(1)(vii) ARGUMENT**

1. The cited reference of *Field* U.S. Patent 4,908,881 Class 2/21 is arguably not in a proper reference since it is not in the same class or in any related field as the instant application class (119/861). More relative prior art exist in class (119/861) but was not relied upon by examiner. Nor was the *Field* patent cited in any of the more closely related patents referenced in the PTO search. Further, there is an obvious misinterpretation of equivalency between human anatomy and animal anatomy as applicable to this case. It is further argued that claim limitations such as (an internal and external shape generally consistent with that of an animal's toe-nail), clearly limits the claimed invention to a particular aspect of an animal's anatomy.
2. A further issue involves examiners unsupported conjecture that the *Field* '881 patented apparatus can be adapted structurally in an unidentified manner for use on animal claws for the purpose intended by applicant.
3. Applicant's previously patented animal toe nail cap had no layering only a single encompassing wall which worked well for some animals such as felines which naturally slough off or shed a toe nail coating as the nail grows. Such sloughing of the nail tends to release the nail cap in only a few days thus the feline cap is needed only a few days. However, it was found over time that canines which do not shed a natural nail sheath as the nail grows needed a nail cap that could last more than twice as long as that of felines and withstand more exposure to rough surfaces.
4. Applicant, being a veterinarian, made the observation and developed a way to produce a layered cap having the proper density or hardness for long wear while not increasing a significant cost in production or excess weight to the cap. It was also found the outer coating or layer only needed to cover the lower half of the cap thus reducing time in the dip, mold and dry process. Methods were also developed for feathering the second layer so as to blend into the first. Using a higher density of material for the second coating or layer made the cap harder at the lower tip end while allowing the upper open end to remain pliable and thus easily deformed for telescopically sliding over the animal's nail.
5. It was also found that using one color for the inner layer 16 and different colors for the partial outer coating or layer 42 helped distinguish between caps having high density and hardness from those with lower density material and hardness.

6. It should also be noted that the caps are used for protecting humans and their habitant from the ravages of animal claws rather than for protecting the claw itself or simply providing decoration. More than two million of the initially patented animal toe nail caps are sold annually in the United States alone.

**Rejection of Claim 1, under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881**

Regarding Claim 1. applicant disputes examiner's contention that the *Field* '881 patent is a proper reference in this case. Assuming a proficient classification search was accorded applicant's application for animal toenail covers the following classes were searched by the PTO. Class 119/850-851, d30/146, 54/82, and 132/73. 132/200. The most closely related prior art being in Class 119/850-851. There are no indication or reference notes that would lead a researcher to the cited *Field* reference in classes A41D, 12/08

It is clearly understood that examiners may conduct their own search and need not rely solely on the initial group search. However, there should be some reason given for departing from the initial search or at least some classification note that would lead a researcher to the class and subclass relied on by the examiner. In this case there is no indication as to why the examiner rambled so far a field. In fact the only relation applicant's application has to the cited reference are the words "toe", "sheath", and "guard" used in the *Field* '881 specification thus indicating a word search and not a technology search. It should also be noted that the *Field* patent was available as prior art to applicant's issued patent 4,962,731 but was not cited in that case. The misuse of the *Field* '881 patent as a reference in this case makes a comparison of the two inventions nearly impossible on every count.

Assuming that the *Field* '881 patent is a proper reference applicant makes the following arguments:

The *Field* '881 patented apparatus is an aesthetically pleasing finger or toe guard and method for fabrication of same for protection of a user's fingertip and/or fingernail or to protect and cover an injured finger or toe. Whereas applicant's invention an "animal toe nail sheath" is an improvement over applicant's disclosed prior art patent 4,962,73 for such animal toe nail covers or sheaths used to protect humans and their environments (furniture etc.) from the ravages of unsheathed animal claws. Applicant's animal toenail sheaths are applied only to the animal's toenails or claws and not to the entire toe.

An important issue is examiner's obvious misinterpretation of an equivalency between human anatomy and animal anatomy as applicable to this case. The *Field* '881 patent makes no mention of an animal or animal toe-nail or claw nor does *Field* suggest in any way that his finger covering can or could be used for animals. Therefore, examiner has failed to show how one of ordinary skill within the art could have been motivated to develop applicant's invention.

Animals and humans have different anatomies and thus are considered as different species. Humans simply do not have "animal claws". Therefore, human finger or toe coverings do not fall within the limitation of the claim. Obviously the PTO recognizes these differences by putting animal apparatus in different classifications than those for humans.

Negating a claim's limitations such as (an internal and external shape generally consistent with that of an animal's toe-nail) which clearly limits the claimed invention to a particular aspect of an animal's anatomy and not that of a human finger is surely an improper claim rejection.

Animal toenails are clearly shaped differently than human fingers. An animal claw or toenail is triangular shaped at its proximate end, tapering and curving to a point at its distal end as may be seen in Fig. 5 of the 4,962,731 Wexler patent, which is incorporated by reference into applicant's application. Whereas, the human finger nail is broad and relatively flat by comparison. The human finger and toenails are only pointed by sculpturing and not by natural growth. Artificial fingernails are simply applied to the upper surface of the nail and do not surround the nail as claimed by applicant. Therefore, there is no comparison between human finger or toe nails and animal toenails. However, to cover the possibility that some animals may not possess claws i.e. chimps elephants etc. (although examiner never made this distinction) the claims in this case were limited to "claws" by amendment.

Regarding claim 1 examiner misidentifies the *Field* finger guard itself as item (44) when in fact item (44) is the open proximal end of the finger guard or sheath like device, and the opening therein as item (46) when in fact item 46 represents a hollow inner bore which seems to indicate a boring operation and not a cavity produced by molding. Such misuse of terms makes it very difficult to follow the rejection.

Examiner, repeatedly erroneously describes the *Field* '881 apparatus as having applicant's claimed "internal and external shape generally consistent with that of an animal's toenail" when in fact there is no indication in the *Field* specification that mentions such shape or a drawing that would lead any rational person to that conclusion. In fact *Field* describes his finger covering as "corresponding to the anatomical shape of a human finger". A human finger shape is simply not consistent with an animal's toenail.

Examiner also indicates that the *Field* "plastic sheath" comprises a second layer of polymer covering at least a portion of the sheath when in fact *Field* makes no mention of a layer of any kind. The layer referred to by examiner is a composition derived by the attachment of a decorative artificial fingernail. Applicant contends that such decorations have nothing to do with the finger covering or sheath. Applicant's toe-nail sheath is a single piece with no removable attachments. It is irrational to assume that the frosting candles and other such decorations on a layer cake constitute additional cake layers. Simply because one object is resting on another does not necessarily mean they are attached or form a layer of the support member. For example a cat lying on a carpet does not make the cat a layer of the carpet nor simply because the cat may become attached to the carpet one cannot assume that an adhesive is involved. Such attachment may simply be the cat's claws.

The *Field* finger sheath is disclosed as a rigid or pliable *plastic* or cloth fabric with an open proximal end and a closed distal tip or alternatively as a Semi-ridged sheath of a semi-pliable *plastic* having a closed distal end, an open proximate end and a hollow inner bore, as shown in Fig. 3, for covering the distal end of a human finger. There is no mention of encompassing only the fingernail or if a fingernail is even present. If the *Field* sheath were made of cloth it would not read on applicant's nail cap at all. Such terms as semi-pliable and semi-ridged are non-definitive and cannot be assumed to be capable of conforming to any shape.

It is inconceivable how or why applicant's toenail sheath could be made out of cloth. The question becomes, at what point does the *Field* sheath anticipate applicant's invention? Is it only when and if it uses the alternative embodiment and only when it includes all the attachments? Since the *Field* sheath has no layer itself it must rely on a detachable artificial fingernail to form such a questionable layer. The *Field* sheath cannot anticipate applicants sheath when applicant's toe-nail sheath has no artificial fingernail attached or a detachable layer? Using examiner's logic virtually, any finger, hand or foot covering such as a glove, sock or shoe would seem to anticipate the *Field* sheath by simply adding some type of removable decoration.

#### **Rejection of Claim 2, under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881**

Claim 2 involves the claim limitation of the second polymeric coating on the sheath as being harder than the polymeric sheath, the covering or sub-layer. Examiner, continually relies on the assumption that the removable decorative artificial finger nail attachment is a polymeric layer or coating and since the artificial finger nail is made of a ridged plastic and the sheath is made of a semi-pliable material, that the nail must be somehow be harder than the sheath. *Field* makes no mention of hardness and thus any assumption made regarding hardness of the materials is

purely speculation. No comparison can be made without knowing the material specification of each member.

The toe nail cover sheath and the external layer are formed from the same polymeric chemicals with only the density being changed by adding additional chemical chains which results in a greater hardness.

Examiner has raised the question of "new matter" as a result of the use of the term density as opposed to hardness. Examiner further states that "a harder material is not necessarily a denser material and as such the density limitation constitutes new matter. This statement is simply not true. The more dense a material is, the harder it is. This is a common fact. Shore durometer hardness test are used to determine the relative hardness of such materials as rubber and polymers. Obviously the more dense the test sample the greater the hardness reading will be. This is indicated by the periodic table in which minerals are ranked by hardness. Therefore, the specific element's atomic weight is a true indication of its density. A diamond is denser than steel and is therefore harder. There is simply no way to separate density from hardness. Shore durometer hardness test are used to determine the relative hardness of such materials as rubber and polymers. Obviously the more dense the test sample the greater the hardness reading will be. This is indicated by the periodic table in which minerals are ranked by hardness. Therefore, the specific element's atomic weight is a true indication of its density. A diamond is more dense than steel and is therefore harder. There is simply no way to separate density from hardness with the same material.

**Rejection of Claim 3, under 35 U.S.C. 103(a) as being anticipated by Field, US Patent 4,908,881**

Claim 3 involves the difference in color of the sheath and its coating. Field *discloses* the fact that artificial fingernails and other such decorations may be prepared in various colors for aesthetic purposes. However, *Field* makes no mention that his finger sheath and the detachable decorative nail should be different colors. Examiner assumes that the colors are only for aesthetic purposes. However, applicant uses the colors as an indication of a difference in layer density or hardness.

Since applicant's animal toenail sheath is a single piece sheath having a polymeric coating it is far from obvious that the second coating should be a different color. In fact it would be more likely that the two materials would be the same color since they are formed from the same chemicals with only the density being changed by adding additional chemical chains which results in a greater hardness. Only by specification of the tints to be used in each batch would the colors be different.



**Rejection of Claim 4, under 35 U.S.C. 103(b) as being unpatentable over Field, US Patent 4,908,881 in view of Johns**

Claim 4 involves the addition of cleats internally to the sheath. Examiner argues that the *Field* reference does not disclose internal cleats but that the *Johns* '981 patent does. Since the *Johns* patent is a finger sheath and not an animal toenail cover there is simply no correlation between them. Further, since examiner seems to relate any raised structure as a cleat as is the case regarding the oval shaped ribs extending both internally and externally circumferentially around the *Johns* sheath, applicant amended claims 4 and 11 using the terms anticline or raised peaks. However, it seems that examiner even objects to these terms and considers them to be equivalents to the *Johns* oval shaped ribs regardless of shape or location limitation that clearly define the raised peaks to be pointed inwardly. Only in hindsight could anyone of ordinary skill envision such an oblique relationship be envisioned. Examiner further extends the scope of the *Johns* teachings of oval shaped ribs to include any textured wall surfaces as well claimed in Applicant's claim 11.

**Rejection of Claims 4 and 11 Under 35 U.S.C. 103 (a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns.**

In rejecting claims 4 and 11 examiner argues that *Field* discloses the invention substantially as claimed. However, examiner also argued under the 35 USC 102 rejection that claim 1 is anticipated by *Field*. Since claim 4 and claim 11 are dependent on claim 1 It seems that either the reference fully discloses the claimed invention or it does not as required under 35 USC 102 not simply substantially discloses the invention.

**Rejection of Claim 5 under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.**

Claim 5 involves a partial delamination between the polymeric sheath and a portion of the external coating of polymer. This is deliberate partial delamination of a portion of the polymer coating from the remainder of the sheath. Examiner erroneously considers the detachable finger nail of the *Field* finger sheath to be a second polymeric coating and that separation of the artificial finger nail from the finger sheath constitutes a delamination. Such an assumption must be based on the premise that a lamination previously existed. The *Field* sheath has no polymeric coating and no lamination existing when the artificial fingernail is not attached. Therefore, there can be no delamination of the *Field* sheath. Since applicant's sheath has no removable fingernail or removable coating, delamination can exist between the sheath and its polymeric coating.

**Rejection of Claim 6 under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.**

Claim 6 involves an adhesive element. Examiner makes the assumption that an adhesive must be present to attach the artificial fingernail to the *Field* sheath even though *Field* makes no such disclosure. It may be possible that the fingernail has a weak adhesive backing. However, since the artificial fingernail is simply decorative and is not an essential element of the sheath, the adhesive cannot be considered as an element of the sheath structure. Whereas, applicant claims the adhesive as an essential structural non removable component of the sheath.

Examiner further argues that although the *Field* reference makes no mention of an adhesive, such an adhesive must be present for attaching the artificial fingernail to the sheath. This simply not true, applicant suggested several other ways that such attachment could be made. However, there is simply no correlation between a phantom adhesive and the limitation by applicant's claim that an adhesive be present within the sheath. An adhesive applied to a decoration that may or may not be applied cannot be considered as an element of the structure.

**Rejection of Claim 7 under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881.**

Claim 7 involving the placement of a liquid adhesive between the polymeric sheath and its external coating of polymer. Examiner fails to distinguish the differences between possibly a weak adhesive (that can be easily removed) applied to a removable decoration and an adhesive injected between two adjacent layers of applicant's toenail sheath deliberately formed for the purpose of containing such adhesive in a liquid form. Such a comparison is simply not logical.

**Rejection of Claim 11, under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns '981**

Claim 11 involves the addition of a textured surface of the sheath's interior wall. Examiner argues that although the *Field* reference does not disclose internal cleats or a textured internal wall surface that the *Johns '981* patent with its oval rings somehow makes the use of a textured surface obvious. Since the *Johns* patent is a finger sheath and not an animal toenail cover there is simply no correlation between them. Further, examiner seems to consider any raised element of a sheath as a textured surface as is the case regarding the Johns oval shaped ribs extending circumferentially around the sheath.

**Rejection of Claim 14-17 under 35 U.S.C. 103(a) as being unpatentable over Field, US Patent 4,908,881 in view of Johns '981**

Claim 14 involves the use of an adhesive powder is applied to the sheath within the nail sheath. The cited references of Field or Johns fail to teach or otherwise suggest the application of an adhesive power. Applicant makes no claim to the use of an adhesive to attach the coating or layer to the sheath. dependent claim 14 refers back to claim 6 which claims only the sheath 16 and not necessarily a coating as having an adhesive element. Claim 6 and 14 make no mention of an adhesive being applied to the layer or coating. Since neither Field or Johns even mentions and adhesive there can be no obviousness regarding the adhesive or the type of adhesive used or where it is applied.

Regarding claims 15, examiner argues that although the *Field* reference makes no mention of an adhesive, such an adhesive must be present for attaching the artificial fingernail to the sheath. There is simply no correlation between a phantom adhesive and the limitation by applicant's claim that an adhesive be present. An adhesive applied to a decoration that may or may not be applied cannot be considered as an element of the structure. Examiner fails to make a distinction between an adhesive located within the nail cap sheath, applied by transfer during the molding process, and an adhesive applied between two adjacent layers of applicant's toenail sheath deliberately formed for the purpose of containing such adhesive in a liquid form.

Regarding claims 16 and 17, examiner argues that an adhesive powder located within the nail cap by transfer during the molding process is not germane to the nail cap itself and that such claims are considered as product by process claims. Applicants maintain that a method of application of an adhesive relates directly to how the nail cap is made. It should be noted that product by process claims are allowable unless the products in question are identical or nearly so. In which case the unobvious differences should be pointed out by applicant. In this case however, there are very distinct and obvious differences.

Claims 27, 28, 30, and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Field, US Patent 4,908,881.

It is an exercise in futility to logically argue the merits of this case when examiner has repeatedly refused to even respond to the case law cited offered by applicant relating to the rules which support the courts rulings requiring Examiners to identify where the prior art provides a motivating suggestion for the disclosed modifications and combinations. See *In re Jones* 958 F,2d 347,21 USPQ.2d [94] (Fed. Cir. 1992).

The courts also held that "Before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so. In re: Fine, 837 F.2d 1071, 1074, 5 USPQ.2d 1596, 1398-99 (Fed. Cir. 1988)." [al 1943]

The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed invention. "Moreover the Courts have advocated that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggest the desirability for the modification. See In re. Fritch, 9922 F.2d 1260, 23 USPQ.2D 1780 (Fed. Cir. 1992)" . "The mere fact that prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention obvious unless desirability of such modification is suggested by prior art... [at 1780] See also Gordon, 733 F.2d at 902, 221 USPQ at 1127." [at 783]

More recently decided cases set forth the need for the cited reference to provide a motivating suggestion that is explicit as decided in Winner International Royalty Corp. v. Wong, No 96.2107, 48 USPQ.2d 1139 (D.C.D.C.1998) Where the court held: ".... Inventions can not be found obvious unless there was some explicit teachings or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." [at 1140] [at 1144].

A failure to respond to the above court rulings and the PTO rules relating thereto seems to indicate a total misunderstanding or a total disregard for such rulings by Examiner in this case. This case is a prime example of why such rulings were made. The product claimed by applicant in this case is made by an entirely different method for an entirely different purpose than that of the Cited *Field* '881 Reference. Further there is nothing to motivate one of ordinary skill to use any teachings found within the *Field* '881 Reference to produce an animal toenail or claw sheath having a non-removable polymeric coating with a greater density and hardness.

Examiner in this case uses hind sight, claim dissection and misidentification of the elements of the *Field* '881 patent to fit any terminology used by applicant. For example; Field discloses a rigid, semi-rigid or pliable plastic or cloth material formed to cover a human's finger or toe. Since applicant amended the claims to use the term "sheath" surrounding the animal's toe nail Examiner makes the assumption that somehow the sheath surrounding a whole human finger is equivalent to a sheath only surrounding an animal's toe nail.

Examiner also considers the term "plastic", as an equivalent to a "polymeric" when in fact those having competence in the art clearly understand that plastics are biological materials that may be heat formed from preformed sheets into various shapes. Whereas, the term "polymeric" is used to identify materials produced by a chemical process reaction by which low molecular weight monomers

are converted to high molecular polymers and used in molding process in a viscous liquid form. In this case a polymeric is used in the form of a polyvinyl chloride dip mold process. Plastics are not used as coatings or used in a dip forming, coating or layering process. The inappropriateness of "plastic" makes the *Field* finger cover impractical for an animal toe-nail cover, especially, as fabricated in the manner described by *Field*.

Regarding Claim 27 Under 35 USC 102 (b) Examiner ignores the claim limitations that clearly define the claim as comprising an external coating of polymer encompassing at least a portion of the sheath. The cited reference of *Field* does not comprise such a coating or polymer applied to the finger guard. Even considering examiner's misapplication of the false fingernail as an element of the finger guard it is not a coating of polymer and does not encompass anything it is simply a detachable element unlike a non-removable coating.

Regarding claims 28 and 34 involving the claim limitation of the second polymeric coating on the sheath as being harder than the polymeric sheath, the covering or sub-layer. Examiner continually relies on the assumption that the removable decorative artificial finger nail attachment is a polymeric layer or coating and since the artificial finger nail is made of a ridged plastic and the sheath is made of a semi-pliable material, that the nail must be somehow harder than the sheath. *Field* makes no mention of hardness and thus any assumption made regarding hardness of the materials is purely speculation. No comparison can be made without knowing the material specification of each member.

Regarding claim 30 involving the creation of a void between the sheath and the polymeric coating, Examiner again erroneously states that the *Field* finger sheath has a coating applied to the sheath. No such coating is even mentioned by *Field*. In addition examiner takes issue with the term 'whereby' stating that the term does not define any structure and cannot serve to distinguish. Examiner is confused. The court held in case law cited by Examiner that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention."

However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby clause in a *method claim* is not given weight when it simply expresses the intended result of a process step positively recited.'" *Id.* < In this case Claim 30 is not a method claim and thus is material to patentability.

Regarding Claims 32 and 33 Under 35 USC 102 (b) Examiner ignores the claim limitations that clearly define the claim as (comprising a non-uniform wall thickness having a greater thickness at its distal end than at its proximate end). The cited *Field* finger guard does not comprise a non-uniform wall thickness and does not encompass an animal claw. Even the misapplication of a removable attachment does not satisfy this limitation. Such an attachment would only add a second wall thickness to a portion of the finger guard and then only when attached. No provision for this limitation is suggested when the false fingernail is detached from the finger guard. Further when the *Field* removable fingernail is detached there is no lamination of the sheath.

Regarding Independent claim 32 Examiner further seems to be unclear as to how a sheath can telescopically encase an animal toenail even though common usage of the term telescopic means the sliding of one element over and along another. The term is also used in applicant's patent 4,962,731 incorporated in the instant application by reference. Nor does adding the decorative false fingernail make the *Field* finger guard or sheath obvious because it does not change the wall thickness in a non-uniform manner. The addition of an attachment only adds a second wall thickness, and then, only when attached. When the artificial nail is removed from the sheath there is no indication of a non-uniform wall thickness.

Regarding claim 35 involving the void located between applicant's toenail or claw sheath and the polymeric coating thereon, examiner erroneously cites the *Field* item 50 as a void when in fact *Field* clearly defines item 50 as a recessed notch formed on the upper surface of the sheath for detachably mounting the artificial fingernail. There is simply no mention of a void or a polymeric coating applied to the *Field* finger sheath.

Claims 29, 36, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Field* U.S. Patent 4,908,881 claims, 31, and 37 are further rejected as being unpatentable in view of *Johns* 2,285,981.

Regarding claim 29, and 36 *Field* discloses the fact that artificial fingernails and other such decorations may be prepared in various colors for aesthetic purposes. However, *Field* makes no mention that his finger sheath and the detachable decorative nail should be different colors. Examiner assumes that the colors are only for aesthetic purposes. However, applicant uses the colors as an indication of a difference in layer density or hardness.

Since applicant's animal toenail sheath is a single piece sheath having a polymeric coating it is far from obvious that the second coating should be a

different color. In fact it would be more likely that the two materials would be the same color since they are formed from the same chemicals with only the density being changed by adding additional chemical chains which results in a greater hardness. Only by specification of the tints to be used in each batch would the colors be different.

Further Regarding claims 29, 36 Examiner seems to regard the use of color only for aesthetic purposes. Color as discussed above provides a means for determining the difference between a nail cap having a higher density polymeric coating from one that does not. Such polymers can be made clear as well. In the absence of color such differences are not obvious. Therefore, color may be considered as an essential element of the claimed nail cap that has nothing to do with aesthetics. Further, there is no suggestion in the *Field* reference that the finger guard itself should be a different color only the nail attachment is suggested as having various colors.

Only through the use of hindsight and the repeated misidentification of the elements and false assumptions could an examiner attempt to force fit the *Field* reference to meet the limitations of applicant's claims. Since the cited reference of *Field* does not identically contain applicant's claimed invention including the limitations the reference does not anticipate applicant's invention.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Examiner has failed to point out where or how the cited prior art teaches or suggest a way to make applicant's claimed invention with any reasonable expectation of success without the use of applicant's disclosure.

Examiner argues that somehow the invention disclosed by the *Field* reference could be adapted for use on a Bear claw. It is doubtful that Examiner has a personal knowledge of such an application nor is it suggested by the cited reference nor is it a common practice in the art to adapt finger sheaths to animal claws.

Regarding claim 36 since the *Field* sheath has no sub-layer there can be no obvious choice of colors. *Field* only alludes to the fingernail itself as having

color and not the sheath. Applicant's animal toenail sheath has a polymeric coating not a fingernail attached thereto.

Regarding claims 31 and 37 relating to the anticline cleats pointed downward towards the distal end. Examiner's argument that the term anticline is inappropriate is simply false. By definition the term anticline means inclined in opposite directions such as a house roof or mountain peak. Therefore, since the field reference does not teach or disclose such a feature limitation and the Johns reference teaches a plurality of bands having an oval shape there is simply no basis for making the assumption that anticline cleats are obvious in view of any shape of ridges within a sheath regardless of purpose. The anticline cleats do not encircle the sheath in the manner disclosed by Johns nor does Johns suggest the use of a row of anticline cleats along one side as taught by applicant. Thus only dissection of the claim and the use of hind site would lead one to make such an assertion and further extend such teaching to include any textured surface.

Regarding independent claim 38 Examiner argues that it would be obvious to make any shaped opening in the sheath consistent with the appendage on which the device is to be placed. This seems to ignore the whole purpose of claim limitations. Everything made by man is a design choice. Therefore, placing design limitation in the claims allows for distinctions between various apparatus.

With regard to obviousness an animal claw is certainly shaped different from a human finger. Using such logic, no patent could be issued for gloves in view of mittens no new hats or shoe designs would be allowed in view of socks that cover the foot. Thus any covering for a human or animal appendage would be obviously a design choice. In this case a triangular opening, or the ability to conform to such a configuration, in the molded cap is simply an unobvious claim limitation since the *Field* reference does not suggest such an opening.

The question raised regarding the use of the term density as opposed to hardness where Examiner states that "a harder material is not necessarily a denser material" is simply not true. The more dense a material is, the harder it is. This is a common fact. Shore durometer hardness test are used to determine the relative hardness of such materials as rubber and polymers. Obviously the more dense the test sample the greater the hardness reading will be. This is indicated by the periodic table in which minerals are ranked by hardness. Therefore, the specific element's atomic weight is a true indication of its density. A diamond is denser than steel and is therefore harder. There is simply no way to separate density from hardness.

Examiner argues that the claimed invention is structurally identical with that of the *Field* "881 reference and that applicant's intended use does not



differentiate the claimed apparatus from the prior art and cites no such case law as a reference for this ruling. This statement is plainly false there are certainly structural differences involved. There is also a good deal of case law to the contrary where a new use for an old technology is allowable especially when the structure is radically different as is the case here. Applicant contends that there is no structural resemblance between the cited reference of *Field* '881 and applicant's animal toenail sheath.

Examiner further fails to identify how the *Field* '881 invention could be adapted for applicant's intended purpose. To satisfy the structural requirement established by examiner to meet applicant's nail cap the *Field* sheath must include the removable artificial fingernail. Therefore, to adapt the *Field* apparatus for use as an animal nail cap the *Field* finger guard would be required to be made of plastic, significantly downsized, reconfigured internally and externally to fit only the nail portion of an animal claw and somehow attach a miniature artificial finger nail to the upper portion of the sheath which still fails to provide a long lasting wear resistant surface on the base of the sheath. This is totally impractical from a manufacturing perspective since the attachment of a removable miniature finger nail to such a totally reconfigured sheath would be cost prohibitive and impractical to produce in any significant quantity and still fails to satisfy the intended purpose of protecting others from the nail.

Examiner further seems to indicate that a general knowledge of manufacturing practices is not germane to the case unless the application specifically claims manufacturing processes. This is absurd reasoning. One must first understand the manufacturing processes involved in making a product in order to understand the limitations imposed by the different methods of manufacturing such products. For example a plastic thermal molding process is entirely different from a dip process. Thus products produced by different process have different limitations.

Ignoring such manufacturing processes leads to confusion and false assumptions, as is the case here. Without an understanding of the manufacturing process used to produce a product it is possible to assume that a glass structure is an equivalent of a polymeric structure having an entirely different shape, thus leading to the conclusion that since both are formed into shapes by different methods and the shapes are a manner of design choice then they must be obvious regardless of their intended shape and/or purpose.

## **(c)(1)(viii) Claims APPENDIX**

### **WHAT IS CLAIMED IS:**

1. An animal toenail covering having an opening at one end and an internal and external shape defining a pliable sheath generally consistent with that of an animal's toenail, said polymeric sheath comprising an external coating of polymer encompassing at least a portion of said polymeric sheath.
2. The animal toenail covering according to claim 1 wherein said external coating of polymer has a hardness greater than that of said polymeric sheath.
3. The animal toe nail covering according to claim 1 wherein said polymeric sheath and said external coating of polymer are different colors.
4. The animal toe nail covering according to claim 1 wherein said polymeric sheath further comprises internal anticline cleats.
5. The animal toenail covering according to claim 1 wherein said polymeric sheath further comprises a partial delamination between said polymeric sheath and a portion of said external coating of polymer.
6. The animal toenail covering according to claim 1 wherein said polymeric sheath further comprises at least an adhesive element.

7. The animal toenail covering according to claim 6 wherein said adhesive element is a liquid adhesive inserted between said polymeric sheath and said external coating of polymer.

8. Cancelled

9. Canceled

10. Cancelled

11. The animal toenail covering according to claim 1 further comprising a textured inner wall surface.

12. Cancelled

13. Cancelled

14. The animal toenail covering according to claim 6 wherein said adhesive element is an adhesive powder.

15. The animal toenail covering according to claim 6 wherein said adhesive element is an aerosol.

16. The animal toenail covering according to claim 14 wherein said adhesive powder is applied to tooling used in a dip molding process for forming said polymeric sheath.

17. The animal toenail covering according to claim 16 wherein said adhesive powder is applied to said tooling by electrostatic means.

18. (canceled)

19. (canceled)

20. (canceled)

21. (canceled)

22. (canceled)

23. (canceled)

24. (canceled)

25. (canceled)

25. (canceled)

26. (canceled)

27. A polymeric animal toenail covering having an internal cavity and an external shape defining a pliable sheath generally consistent with that of an animal toenail for incasing an animal toenail said sheath comprising an external coating of polymer encompassing at least a portion of said sheath.

28. The polymeric animal toenail covering according to claim 27 wherein said external coating has a greater hardness than said covering.

29. The polymeric animal toenail covering according to claim 27 wherein said coating is a different color than said sheath.

30. The polymeric animal toenail covering according to claim 27 wherein said coating is applied to said sheath in manner whereby a void is formed between said coating and a portion of said sheath.

31. The polymeric animal toenail covering according to claim 27 wherein said sheath comprises a plurality of pliable anticline cleats located within said internal cavity protruding inwardly.

32. A polymeric animal toenail covering having a closed distal end and a open proximate end said covering having an internal cavity and a external shape defining a pliable sheath generally consistent with that of an animal toenail for telescopically encasing an animal toenail said sheath comprising a non-uniform wall thickness having a greater thickness at said distal end than at said proximate end.

33. The polymeric animal toenail covering according to claim 32 wherein said non-uniform wall thickness is a lamination of layers.

34. The polymeric animal toenail covering according to claim 33 wherein said lamination of layers comprises an outer layer having a hardness greater than any sub-layer.

35. The polymeric animal toenail covering according to claim 33 further comprising a void located between said layers.
36. The polymeric animal toenail covering according to claim 34 wherein said outer layer is a different color than that of said sub-layer.
37. The polymeric animal toenail covering according to claim 32 further comprising a plurality of anticline shaped flexible gripping elements located within said cavity pointing towards said distal end.
38. A polymeric animal toenail sheath having an exterior surface and a rectangular opening to an interior cavity both exterior surface and said interior cavity defining a pliable sheath having a general shape consistent with that of an animal toenail said sheath defining a telescopic relationship over an animal toenail, encasing and providing protection there from, said sheath comprising a polymeric overlay conforming to said general shape of said exterior surface.
39. The Polymeric animal toenail covering according to claim 38 wherein said overlay is a different material composition than said sheath.

**(c)(1)(ix) EVIDENCE APPENDIX**

**NONE**

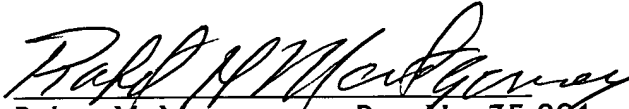
**(c)(1)(x) RELATED PROCEEDINGS APPENDIX**

**NONE**



Please contact the submitter if any fees are due.

Respectfully submitted,



Robert N. Montgomery, Reg. No. 35,291

Date: 27 October 2006

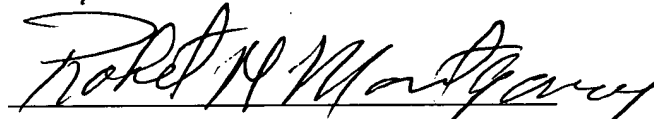
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Robert N. Montgomery